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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/988,821
Filing Date: November 20, 2001
Appellant(s): VIDAL ET AL.

Merchant & Gould P.C.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 24, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct. However, the rejection of claims 1-26 as unpatentable under 35 U.S.C. 103(a) over Peterson in view of Morishige is being withdrawn. Peterson as modified by Morishige does not fairly teach application of a duct or plurality of ducts within which communication cables extend from one point to a second offshore point.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct. However, the question of whether claims 1-26 are unpatentable under 35 U.S.C. 103(a) over Peterson in view of Morishige is not an issue since, as stated above, the rejection of claims 1-26 as unpatentable under 35 U.S.C. 103(a) over Peterson in view of Morishige is being withdrawn.

(7) Grouping of Claims

Appellant's brief includes a statement that claims (1-11, 16-21, and 23), (22, 25, and 26), and 12 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). (The rejection of claim 12 as unpatentable under 35 U.S.C. 103(a) over Peterson in view of Morishige is being withdrawn.)

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,722,793	Peterson	3-1998
6,164,872	Morishige	12-2000

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-10 and 13-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morishige in view of Peterson.

Morishige discloses, Figs. 38, 42, and 44, for example, installing a plurality of ducts and cables 6036, (cables shown by circular 6036 with the ducts shown as that part of tunnel surrounding the cables 6036), extending from one onshore first point to an offshore point or "offshore termination point", at or along 6013 or any point of 6002 extending along the seabed, as well as from another onshore second point to an or the same offshore point, (see Fig. 38, for example). Sections 6002 and 6022 also constitute a plurality of ducts through which cables 6036 extend. However, Morishige appears silent as to how the cables are run/connected along the assembly.

Peterson discloses installation of a plurality of cables from one onshore first point to an offshore point, or "offshore termination point", as well as from another onshore second point to an or the same offshore point, col. 1, lines 37-47; col. 2, lines 16-23; col. 3, lines 57-65; 6, lines 36-43; and co. 6, line 57 to col. 7, line 6. The cables may be placed from onshore to offshore or from offshore to onshore. The offshore point, or

"offshore termination point", can be an offshore platform and may extend several kilometers including up to and more than 50 kilometers from the shore, col. 3, lines 57-65. In both Morishige and Peterson the extension of the ducts and cables can be seen as spanning a shallow region as well as a relatively deep region of water which would inherently include a continental shelf portion of an ocean floor. Peterson teaches splice connection of cables at a "sea end" or offshore point as by a cable joint, col. 7, lines 4-7 and col. 2, lines 19-22.

To have extended the ducts and cables of Morishige from either onshore point to offshore point, or from offshore point to onshore point, for as much as at least 2 kilometers and up to about 20 kilometers from either onshore point to an offshore point as well as span a continental shelf in the process with the depth of an offshore point being at or less than 200 meters, thus covering all offshore intervals which would be included within a onshore to onshore span, (i.e., including all depths, lengths, and formations within the span of water), would have constituted an obvious expedient to one having ordinary skill in the art at the time the invention was made in view of Peterson with Peterson disclosing the flexibility or adaptability of either direction of point to point installation, (i.e., Peterson teaches either onshore point to offshore point, or offshore point to onshore point). To have provided for splice connections anywhere along the span of the tunnel ducts 6002/6022, thus allowing for deployment of shortened, more manageable communication cable lines as well as to distribute the necessary utilities to the various corresponding components such as lights 6033, would have constituted a further obvious expedient to one having ordinary skill in the art at the

time the invention was made in view of Peterson's teachings at col. 7, lines 4-7 and col. 2, lines 19-22. With such a modification of connecting cables at one if not various points along the Morishige tunnel Morishige, as modified, would provide for first and second cables as well as third and fourth cables, 6036 of Fig. 44, with a first cable extending from a first point to an offshore point and connected to a second cable extending from a second point while a third cable extending from a point of location to an offshore point is connected to a fourth cable extending from another point of location. In other words, cables from opposite ends would constitute cables extending from various points onshore to a point or points offshore with ends of the cables being spliced or connected one to another.

(11) Response to Argument

Appellant's arguments spanning pages 5-11 of the brief on appeal do not appear to specifically address either of the rejections applied against the claims on appeal. In any event, as for Appellant's arguments against Morishige in view of Peterson, Peterson had been utilized to teach the flexibility, or adaptability, of either direction of point to point installation of cables within a marine environment. Peterson had also been used to teach distance of application as well as connection of cables at an offshore point. The principle of such application of cables can readily be applied to the Morishige environment and method. Thus, the rejection of Morishige in view of Peterson is rational. And, Morishige is within the field of marine construction involving placement and spanning of conduits and cables.

As for Applicant's arguments against Morishige, the cables and conduits of Morishige would, most certainly, originate from an off shore point, (as beyond either side of Fig. 38), as is well established in the marine environment tunnel construction field. And, one or more cables of Morishige would and do terminate at points within the tunnel, (i.e., offshore points), in order to distribute the necessary utilities to the various corresponding components such as lights 6033, as would be realized by one of ordinary skill in the art of marine construction. See, for example, col. 30, line 65 to col. 31, line 8. And, Morishige discloses a plurality of ducts as with the ducts shown along either side of the tunnel surrounding the cables 6036 or as with duct sections 6002 and 6022 also constituting a plurality of ducts through which cables 6036 extend. The language of the rejected claims is met by the combination of Morishige in view of Peterson as has been set forth in the above rejection.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

M. Safavi
August 13, 2004

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